

REMARKS

The present patent application has been reviewed in light of the Office Action dated February 3, 2011. Claims 1-11, 13-14, 17-26, 28-30 and 32-80 are currently pending, of which, Claims 1, 17, 23, 38, 52, 53, 58, 66, 69, 72 and 78 are in independent form. By the present Amendment, Claims 75-78 have been added, and Claims 1, 3, 17, 23, 38 and 58 have been amended.

Each independent claim includes at least a recitation of a cellular telephone or mobile communications device having a dedicated key for transmitting (or transferring) a telephone directory (or a portion thereof) to a remote central station (or at least one computing device), and/or at least a recitation of the cellular telephone or mobile communications device having a dedicated key for receiving a telephone directory (or a portion thereof) from the remote central station (or at least one computing device).

In the Office Action, Claim 23 was rejected under 35 USC Section 112, first paragraph. The Examiner states that "Claim 23's disclosure of a 'backup dedicated key' is directed to new matter because no formal support can be found in the specification at the time the application was filed." Applicants respectfully submit that their published patent application US 2004/0029568 A1 at paragraph 0044 describes a SEND key for transmitting a telephone directory or a portion thereof to a remote central station 110. Further, at least paragraphs 0030 and 0041 of the published patent application describe the inventive system as being "capable of storing the telephone directory or the portion thereof as a temporary or permanent **backup**," and retaining the telephone directory "within the memory 130 of the remote central station 110 as a **backup** telephone directory after the telephone directory is transferred to the cellular telephone 120." (Paragraphs 0030, 0041, Emphasis added) One can appreciate from reading the disclosure

that the SEND key can be described as a backup dedicated key for transferring the telephone directory or a portion thereof to the remote central station for temporary or permanent storage. Nonetheless, the word “backup” has been deleted from Claim 23 to expedite the allowance of the present patent application. Accordingly, withdrawal of the rejection is respectfully requested.

A. Claim Rejections under 35 USC Section 103(a)

Claims 1-11, 32-34, 38-47 and 49 were rejected under 35 USC Section 103(a) as being unpatentable over Sagar (previously cited by the Examiner) in view of Brown (previously cited by the Examiner) and further in view of U.S. Patent No. 7,003,327 B1 issued to Payne et al. on February 21, 2006 (“Payne et al.”).

Claims 13-14, 35, 48 and 50-51 were rejected under 35 USC Section 103(a) as being unpatentable over Sagar, Brown and Payne et al. and further in view of Comp (previously cited by the Examiner).

Claims 17-20, 22-23, 26, 28-30, 37, 53-55, 57-58, 61-65 were rejected under 35 USC Section 103(a) as being unpatentable over Comp in view of Brown, further in view of Payne et al.

Claims 21, 24-25, 36, 56, 59-60 were rejected under 35 USC Section 103(a) as being unpatentable over Comp, Brown and Payne et al., further in view of Sagar.

Claim 52 was rejected under 35 USC Section 103(a) as being unpatentable over Comp in view of Payne et al.

Claims 66-74 were rejected under 35 USC Section 103(a) as being unpatentable over Brown in view of Payne et al.

All of the rejections are respectfully traversed.

Independent Claims 1, 17, 23, 38 and 58 were amended herein to better describe and/or clarify Applicants' claimed subject matter, and not for patentability purposes.

35 USC Section 103(a) states as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious **at the time the invention was made to a person having ordinary skill in the art** to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. (Emphasis added)

B. Payne et al. is not a proper 35 USC Section 103(a) reference

It is respectfully submitted that Payne et al. or U.S. Patent No. 7,003,327 B1 ("the '327 patent") issued from a patent application filed on June 14, 2000 and assigned U.S. Patent Application Serial No. 09/594,302 ("the '302 patent application"). The '302 patent application claimed priority to a provisional patent application. The '302 patent application was not published prior to issuance as the '327 patent. Therefore, the first time the disclosure of the '302 patent application and its corresponding '327 patent was publicly accessible was on February 21, 2006—the date the '327 patent issued.

February 21, 2006 is several years after the time of Applicants' invention and after the time of Applicants' constructive reduction to practice. Accordingly, a person having ordinary skill in the art to which said Applicants' subject matter pertains would not have been able to publicly access the disclosure of the '327 patent (Payne et al.) at the time Applicants' invention was made, let alone, access the disclosure of the '327 patent and combine its teachings with the disclosures of Sagar and Brown in an attempt to deem Applicants' claimed subject matter obvious as set forth in the Office Action.

The U.S. Court of Appeals for the Federal Circuit in *Cohesive Technologies, Inc. v. Waters Corp.*, decided on October 7, 2008, stated "[d]espite the often quoted maxim that anticipation is the 'epitome of obviousness,' *In re Kalm*, 378 F.2d 959, 962 (CCPA 1967), novelty under 35 U.S.C. § 102 and non-obviousness under 35 U.S.C. § 103 are separate conditions of patentability...."¹ As noted by the Federal Circuit in *Cohesive Technologies*, while anticipation requires that the entire invention be found within a single reference, there is no requirement, as there is in the obviousness analysis, to address each of the Graham factors: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; (4) objective evidence of non-obviousness; and (5) secondary considerations (i.e., commercial success, long-felt but unsolved needs, and failure of others).²

¹ *Cohesive Technologies* at 14 (citing 35 U.S.C. § 282 (2000); *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) ("[T]hough anticipation is the epitome of obviousness, [they] are separate and distinct concepts.")).

² *Graham et al. v. John Deere Co. of Kansas City et al.*, 383 U.S. 1 (1966).

With respect to at least Graham factors (1) and (3)--the only two of the five Graham factors which refer to the prior art--the '327 patent (Payne et al.) is not prior art with respect to Applicants' pending patent application and hence, at least Graham factors (1) and (3) cannot be addressed in the obviousness analysis. Prior art is generally defined as all information made publicly available before a given date that could be relevant to a patent application's claims of novelty. In the current case, Payne et al. was not publicly available before August 7, 2003 or August 7, 2002, i.e., Applicants' respective utility and provisional application filing dates, and therefore is not prior art which can be addressed in any obviousness analysis using the five Graham factors with respect to Applicants' pending patent application.

Accordingly for at least the reasons presented in this section, withdrawal of all the rejections under 35 USC Section 103(a) with respect to all the claims, i.e., Claims 1-11, 13-14, 17-26, 28-30 and 32-74, since Payne et al., an improper reference under 35 USC Section 103(a), is combined with other references to reject these claims in each of the rejections, and allowance thereof are respectfully requested.

C. The cited combinations of references do not disclose or suggest Applicants' claimed subject matter

Assuming arguendo that Payne et al. is a proper prior art reference under 35 USC Section 103(a), Sagar, Brown and Payne et al., taken alone or in any proper combination, does not render Applicants Claims 1-11, 32-34, 38-47 and 49 obvious under 35 USC Section 103(a).

Additionally, assuming arguendo that Payne et al. is a proper prior art reference under 35 USC Section 103(a), Sagar, Brown, Payne et al. and Comp, taken alone or in any proper

combination, does not render Applicants' dependent Claims 13-14, 35, 48 and 50-51 obvious under 35 USC Section 103(a).

Further, assuming *arguendo* that Payne et al. is a proper prior art reference under 35 USC Section 103(a), Comp, Brown and Payne et al., taken alone or in any proper combination, does not render Applicants' Claims 17-20, 22-23, 26, 28-30, 37, 53-55, 57-58 and 61-65 obvious under 35 USC Section 103(a).

Further still, assuming *arguendo* that Payne et al. is a proper prior art reference under 35 USC Section 103(a), Comp, Brown, Payne et al. and Sagar, taken alone or in any proper combination, does not render Applicants' dependent Claims 21, 24-25, 36, 56 and 59-60 obvious under 35 USC Section 103(a).

Furthermore, assuming *arguendo* that Payne et al. is a proper prior art reference under 35 USC Section 103(a), Comp and Payne et al., taken alone or in any proper combination, does not render Applicants' independent Claims 52 obvious under 35 USC Section 103(a).

Finally, assuming *arguendo* that Payne et al. is a proper prior art reference under 35 USC Section 103(a), Brown and Payne et al., taken alone or in any proper combination, does not render Applicants' Claims 66-74 obvious under 35 USC Section 103(a).

The Examiner states in the Office Action, for example, on pages 7 and 21, that "It is well known in the art that to transmit or send data to a network, server, service provider, a SEND button/key, for example, is used for the process. The Examiner states that one skilled in the art would have found obvious that, from Sagar's and Brown's disclosure (see page 7 of the Office Action) and Brown's disclosure only (see page 21 of the Office Action), a SEND button/key is a

dedicated button or key to transmit or send data to a server or network.” Furthermore, the Examiner states in the Office Action, for example, on page 30, that Brown discloses a method of “receiving at least a portion of the telephone directory by the mobile communications device after selection of a second dedicated key of the mobile communications device.”

However, Applicants’ undersigned representative cannot identify any disclosure or suggestion in any of the cited references of a cellular telephone or mobile communications device having a dedicated key for transmitting (or transferring) a telephone directory (or a portion thereof) to a remote central station (or at least one computing device), and/or a cellular telephone or mobile communications device having a dedicated key for receiving a telephone directory (or a portion thereof) from the remote central station (or at least one computing device), as recited by Applicants’ independent claims.

The Examiner relies in the various rejections under 35 USC Section 103(a) on Payne et al. to address the deficiencies of Sagar, Brown and/or Comp with respect to Applicants’ claimed subject matter of a “dedicated key”. However, as with Sagar, Brown and Comp, Payne et al. does not disclose or suggest a dedicated key for transmitting (or transferring) a telephone directory (or a portion thereof) to a remote central station (or at least one computing device), and/or a cellular telephone or mobile communications device having a dedicated key for receiving a telephone directory (or a portion thereof) from the remote central station (or at least one computing device), as recited by Applicants’ independent claims.

Payne et al. is directed to a method and apparatus for implementing a heuristic user interface for a mobile device that assists a user with the management and utilization of contact

identifiers. The mobile device is described as having user function-assignable softkeys 204A and 204B. According to Payne et al. (see, e.g., the abstract):

Content stored on or being processed by a mobile device is analyzed for the presence of predetermined classes of contact identifiers. When a contact identifier belonging to one of the predetermined classes is encountered, it is presented to the user of the mobile device on the display screen and the user interface of the mobile device is provisioned (e.g., **softkey assignments** and screen displays) for the particular class of contact identifier encountered. The encountered contact identifiers may be used as direct contact identifiers or indirect contact identifiers. Direct contact identifiers are used to initialize the appropriate application for the class of identifier encountered (e.g. an email application for an email contact identifier) and establish contact with an associated entity (e.g. an email addressee). Indirect contact identifiers are used to retrieve locally and remotely held records containing the encountered contact identifiers.” (Emphasis added)

Payne et al. describes the mobile device as having softkeys 204A and 204B which are function-assignable keys. There is no description in Payne et al. that these keys are dedicated keys. Assignable or user-programmable keys are well known in the art; they can be assigned by a user to perform a user-selected function. See, e.g., “How to Change What a Key Is on a QWERTY Keyboard in Microsoft on a Dell,” by David Weinberg, http://www.ehow.com/print/how_7492135_change-qwerty-keyboard-microsoft-dell.html (a copy of which is provided herewith). In contrast, dedicated keys, as recited by Applicants’ independent claims, cannot be assigned by a user to perform a user-selected function.

In particular, Payne et al. describes user-programmable or assignable softkeys 204A and 204B which can be assigned or programmed by a user to perform a function selected from a set of functions. In particular, with reference to Figures 2A-2G, Payne et al. at column 7, lines 1-7 and lines 32-38; at column 8, lines 35-38 and lines 47-53; and column 8, line 66 to column 9, line 1 and with reference to Figures 2A-2F describes assignable softkeys 204A and 204B and their associated softkey identifiers 214A and 214B. According to the teachings of Payne et al., sofkey identifiers 214A and 214B identify the **function assigned at any given time** to

assignable softkeys 204A and 204B, respectively, by the user. Payne et al. describes each assignable softkey 204A and 204B as follows (commentary is provided by the undersigned in brackets):

FIG. 2A is a diagram of a mobile device 202, which may be mobile device 102 of FIG. 1. Mobile device 202 has a keypad 208, softkeys 204A and 204B and a navigation rocker 206, and has a display screen 203, which provides associated softkey identifiers 214A and 214B, a symbolic indicator 210 and a scroll indicator 218, that allows a user thereof to interact with mobile device 202.

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In accordance with the principles of the present invention, a user of a mobile device (e.g. mobile device 202) may initiate automatic contact identifier analysis by pressing a predetermined key (e.g. soft key 204B) or the analysis may be initiated without user intervention upon the occurrence of a predetermined event (e.g. the reception or designation of an email message). **[Describes that automatic contact identifier analysis can be initiated by pressing the function-assignable softkey 204B (after softkey 204B has been assigned the function of initiating automatic contact identifier analysis).]**

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By activating a predetermined key (e.g. softkey 204B) the available resource is retrieved, as displayed at 238 in FIG. 2C. In this example the available resource is an address book entry for Mary Doe. **[Describes that an available resource can be retrieved by activating or pressing function-assignable softkey 204B (after softkey 204B has been assigned the function of retrieving an available resource).]**

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Referring now to FIG. 2D, the string <doe@corp.com> has been identified and highlighted (240) in the bottom of screen display 203. Indicator 242 provides an indication that <doe@corp.com> has been classified as an email contact identifier and may be used to send an email message by activating softkey 204A. Softkey identifier message 214A indicates that the associated softkey 204A **has been assigned the function of** email initiation. More specifically, activation of softkey 204A causes an email application to be initialized by the mobile device and the email contact identifier to be automatically inserted in the <To:> field of the email message 248 as is illustrated in FIG. 2E. (Emphasis added) **[Describes that the function of email initiation has been assigned to function-assignable softkey 204A.]**

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The softkey identifier 214A indicates that the associated softkey 204A **has been assigned the function of** initiating dialing. (Emphasis added) **[Describes that the function of initiating dialing has been assigned to function-assignable softkey 204A.]**

For at least the reason that Payne et al. does not address the deficiencies of Sagar, Brown or Comp, as discussed in this section, withdrawal of the various rejections combining Payne et al. with Brown, Comp and/or Sagar to reject independent Claims 1, 17, 23, 38, 52, 53, 58, 66, 69 and 72 is respectfully requested. Additionally, allowance of independent Claims 1, 17, 23, 38, 52, 53, 58, 66, 69 and 72 is also respectfully requested.

Dependent Claims 2-11, 13-14, 18-22, 24-26, 28-30, 32-37, 39-51, 54-57, 59-65, 67-68, 70-71 and 73-74 depend from either independent Claim 1, 17, 23, 38, 53, 58, 66, 69 or 72 and therefore include the limitations of independent Claims 1, 17, 23, 38, 53, 58, 66, 69 or 72. Accordingly, for at least the reason presented in this section with respect to independent Claims 1, 17, 23, 38, 53, 58, 66, 69 or 72, dependent Claims 2-11, 13-14, 18-22, 24-26, 28-30, 32-37, 39-51, 54-57, 59-65, 67-68, 70-71 and 73-74 are patentably distinct over the cited combinations of references. Hence, withdrawal of the rejections with respect to dependent Claims 2-11, 13-14, 18-22, 24-26, 28-30, 32-37, 39-51, 54-57, 59-65, 67-68, 70-71 and 73-74 under 35 USC Section 103(a) and allowance thereof is respectfully requested.

C. New Claims 75-80

New Claims 75-77 depend from either independent Claim 1, 17 or 52. Accordingly, for at least the reason presented in the previous section with respect to independent Claims 1, 17 and 52, new dependent Claims 75-77 are patentably distinct over the teachings of the prior art of record.

New Claims 78-80 are patentably distinct over the teaching of the prior art of record.

It is respectfully submitted that all the pending claims are in condition for allowance. In view of the foregoing amendments and remarks, reconsideration of the application and allowance of the claims is earnestly solicited.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicants' undersigned representative at the number indicated below.

Respectfully submitted,

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